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Paper No. 26

10/24/00

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **AutoNation Incorporated**

Serial No. 75/126,813

Mark H. Tidman of Baker & Hostetler LLP for AutoNation Incorporated

Angela M. Micheli, Trademark Examining Attorney, Law Office
108 (David Shallant, Managing Attorney)

Before Simms, Hohein and Wendel, Administrative Trademark
Judges.

Opinion by Simms, Administrative Trademark Judge:

AutoNation Incorporated (applicant), a Florida
corporation, has appealed from the final refusal of the
Trademark Examining Attorney to register the asserted mark
shown below

for automobile repair and maintenance services.¹ The Examining Attorney has refused registration under Sections 1, 2, 3 and 45 of the Trademark Act, 15 USC §§ 1051, 1052, 1053 and 1127, on the ground that the asserted mark fails to function as a service mark.

Applicant and the Examining Attorney have submitted briefs but no oral hearing was requested.²

The specimens of record consist of a full-page newspaper advertisement. The advertisement shows, in the middle of the page, the asserted mark along with six other traffic signs inside of which is such wording as "RECONDITIONED-TO-PERFORM-LIKE-NEW", "1 (in design) LOW PRICE", "HAGGLE" (with the international prohibition symbol), "WARRANTY 99 DAY", "MONEY-BACK GUARANTEE \$" and "SERVICE CENTER" (with design of a wrench). The text in the advertisement includes the following:

¹ Application Serial No. 75/126,813, filed June 27, 1996, based upon applicant's allegation of a bona fide intention to use the mark in commerce. Before applicant's mark was published for opposition, applicant submitted an amendment to allege use, claiming use in commerce since November 8, 1996. Thereafter, this refusal was made.

On August 17, 1999, the Board issued a decision affirming this Examining Attorney's refusal to register the identical mark for automobile dealership services (Serial No. 75/126,814, filed June 28, 1996). That decision has been appealed to the U.S. Court of Appeals for the Federal Circuit.

² The Examining Attorney has objected to certain exhibits submitted "with [applicant's] brief." We see no exhibits attached to applicant's brief. Rather, they were appropriately submitted with applicant's request for reconsideration and thus are properly of record.

An automotive revolution has been unveiled right here in South Florida. No, it's not a new kind of car. It's a whole new way to buy cars. It's called AutoNation USA, and it is revolutionizing the entire car-buying process. With a mega-selection of up to 1,000 pre-owned vehicles to choose from. With remarkably low, no haggle prices. With a state-of-the-art Automotive Service Center. And with other unique features...

Applicant has also submitted as supplemental specimens a newsletter and photographs showing the asserted mark in applicant's facility.

Essentially, it is the Examining Attorney's position that the asserted mark appears as an informational statement that does not identify and distinguish applicant's services. The Examining Attorney notes that applicant's asserted mark appears with six other similar traffic sign designs which contain highly descriptive phrases or informational statements highlighting the features of applicant's services, such as low prices, a 99-day warranty, a money-back guarantee, etc. The Examining Attorney argues that a consumer would see "AutoNation USA" as the name of applicant's facility and would not view the proposed mark as identifying and distinguishing applicant's services. Further, the Examining Attorney contends that if applicant's advertisement contained only applicant's asserted mark without the identifying name "AutoNation

USA", a consumer would have no idea of the source of applicant's services.

It is also the Examining Attorney's position that the use of "carriers" to highlight information concerning one's services is often used in advertisements to inform the public of features of the goods or services being promoted. The Examining Attorney has submitted some examples of what she regards as usage similar to applicant's. Finally, the Examining Attorney contends that the use of the designation "TM" does not alter the perception of the asserted mark to potential purchasers.

Applicant, on the other hand, aside from arguing that newspaper advertisements promoting one's services under the mark are appropriate specimens, argues that the asserted mark, while also alluding to an aspect of its services, serves to identify the source of applicant's services. Applicant contends that the fact that the asserted mark also provides information or describes a characteristic of applicant's services does not mean that it cannot also function as a service mark. Applicant correctly points out that a product or service may bear more than one trademark or service mark. Also, applicant contends that the fact that the asserted mark appears with additional information and other marks does not diminish the ability of this

asserted mark to function as a source identifier. In this regard, applicant also points to the "TM" designation used in connection with its asserted mark. Applicant distinguishes the third-party advertisements submitted by the Examining Attorney as being of highly descriptive phrases which merely highlight various features concerning the goods or services being advertised. With its request for reconsideration, applicant noted that it has obtained two registrations of the mark "1 LOW PRICE" and design for automobile dealership services and for automotive repair and maintenance services based upon specimens identical to those submitted herein. Applicant argues that this is evidence that the asserted mark does function as a service mark to identify and distinguish applicant's services and that purchasers will recognize the traffic design motif of its numerous design marks. Applicant also points to what it regards as copying of its "family of traffic-sign marks" as evidence that its asserted mark functions as a service mark.³

The determination of whether an asserted mark functions as a service mark depends upon how it is used and

³ Applicant stated in its brief that the Examining Attorney had withdrawn the approval of its amendment to allege use. We can find no such approval in this record. The notice of publication

how potential purchasers will perceive it. In re Information Builders Inc., 213 USPQ 593 (TTAB 1982) and cases cited therein. It should be noted that the Examining Attorney is not contending that newspaper advertisements cannot function as appropriate service mark specimens.

Upon careful consideration of this record and the arguments of the attorneys, we affirm the refusal of the Examining Attorney. It is our opinion that the asserted mark, conveying information that applicant has a large selection of automobiles, is not one which functions as a service mark for applicant's services and is registrable on the Principal Register. We agree with the Examining Attorney that potential purchasers will view the asserted mark as merely providing information about the features of applicant's automobile dealerships (that it has a large selection of automobiles for sale) and not as a service mark identifying and distinguishing the source of applicant's automobile repair and maintenance services. While a different Examining Attorney has permitted registration with respect to a different asserted mark, apparently on the basis of similar specimens, it should be noted that the Board is, of course, not bound by decisions

was issued after review of applicant's intent-to-use application and was not an approval of the amendment to allege use.

of Examining Attorneys in other applications. In re Pennzoil Products Co., 20 USPQ2d 1753, 1758 (TTAB 1991). Each case must be decided on its own merits. Also, merely because an applicant intends an asserted mark to function as a mark does not mean that it in fact does so function. See In re Morganroth, 208 USPQ 284, 287 (TTAB 1980). Finally, the fact that someone has copied from one of applicant's advertisements does not, in and of itself, mean that the copied matter functions as a trademark. See, for example, Kegan v. Apple Computer Inc., 42 USPQ2d 1053, 1060 (N.D.Ill. 1996).

Decision: The refusal of registration is affirmed.

R. L. Simms

G. D. Hohein

H. R. Wendel
Administrative Trademark
Judges, Trademark Trial
and Appeal Board